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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/060,753	01/30/2002	Toshifumi Komatsu	970.0098US01	6971

57557 7590 01/09/2008  
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EXAMINER
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WALKE, AMANDA C

ART UNIT	PAPER NUMBER
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1795

MAIL DATE	DELIVERY MODE
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01/09/2008

PAPER

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/060,753  
Filing Date: January 30, 2002  
Appellant(s): KOMATSU ET AL.

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Daniel M. Pauly  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 10/25/2007 appealing from the Office action mailed 10/30/2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,922,506	HOOGMARTENS et al.	7-1999
6,106,992	ASANO et al.	8-2000

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1-3, 5-6, 9, 17, 19, 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over HOOGMARTENS et al. (US 5,922,506) in view of ASANO et al. (US 6,106,992).
  - a. In US 5,922,506, HOOGMARTENS et al. teach a negative-working photosensitive imaging element comprising on a hydrophilic surface of a support in the order given, a hydrophobic photopolymerization layer contiguous to the hydrophilic surface of the support and comprising at least part of at least one unsaturated compound, a hydrophobic photosensitive layer contiguous to the polymerizable layer and comprising at least part of at least one hydrophobic thermoplastic polymer and at least one photoinitiator and optionally a receptor layer (claim 1). The thermoplastic polymers are used in an amount of at least 50% by weight and examples thereof include polyvinyl acetate (column 6, lines 50-51; column 8, lines 47-54). Agents to improve the wetting an/or adjust the adhesion of the photopolymerizable composition may be added (column 7, lines 37-43 & column 8, lines 42-46). The support can comprise a polyethylene layer (column 10, lines 44-54) and comprise one or more hydrophilic layers such as layers of hardened polyvinyl alcohol (column 10, lines 25-36). The support meets the present limitations for the carrier layer and the hydrophilic layer coated thereon meets the present limitations for the membrane layer. The imaging element of Hoogmartens et al. may comprise a temporary protective layer on top of the photosensitive layer, which can comprise polyvinyl alcohol. The temporary layer can be removed before or after the photoexposure step (column 10, lines 62-67). Preferably the

imaging element either comprises a receptor layer or a transfer layer and a receptor layer wherein the transfer layer is between the photosensitive composition and the receptor layer. Suitable receptor layers include transparent organic resins (column 11, lines 1-25). The temporary protective layer and the receptor layer meet the present limitations for the ink-receptive, radiation transmissive layer. Additionally the temporary protective layer meets the present limitations for the printable cover sheet. Hoogmartens et al. do not teach organic or inorganic particles in the temporary protective layer or the receptor layer however, based on the teachings of ASANO et al. (column 14, lines 55-67 & column 21, lines 33-46) it would have been obvious to incorporate fillers such as calcium carbonate into either layer to reduce to cost and increase handleability. Preferably, the fillers are used in an amount of 10 to 500 parts by weight (col. 14, lines 64-67). The imaging element is then image-wise exposed to actinic radiation (HOOGMARTENS et al; column 13, line 46 – column 14, line 58).

#### **(10) Response to Argument**

Appellant argued that one of ordinary skill would not combine the teachings of Asano with Hoogmartens because Asano is directed to a positive working film and Hoogmartens is directed to a negative working film. Appellant also argued that the reference fail to teach an ink receptive layer or that an image is printed on the ink receptive layer, however Hoogmartens teaches that a receptor layer may be present as discussed above. Applicant further argues there is no teaching for an ink receptive layer in Asano and that calcium carbonate is only incorporated into the interior layers and not present in a layer near the exterior surface of the multilayer film. Hoogmartens clearly teaches the use of temporary protective layer, transfer layer, and receptor layer which is stable in the processing conditions, thus inferring that it is present during

processing after exposure and not removed. The protective layer is the layer that is removed (column 10, line 59 to column 11, line 45), and clearly since the receptor layer is part of the imaging element, and undergoes photoexposure and subsequent processing, that an image would be printed on the layer. The Examiner relied upon the teachings of Asano for the sole purpose to show it would be obvious to incorporate a filler, such as calcium carbonate, into the temporary protective layer. According to Asano, it would have been obvious to incorporate such fillers in a photosensitive resin composition to reduce cost and to improve handleability (column 14, lines 55-67 & column 21, lines 33-46). It is the Examiner's position that it would have been obvious to incorporate the filler in the receptor layer or the temporary cover sheet for the same reasons.

b. In response to Applicant's argument that there is nothing in Asano that indicates beneficial properties of the calcium carbonate or useful improvements in performance once can obtain from the incorporation of the calcium carbonate, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Again, it would have been obvious to incorporate fillers such as calcium carbonate in a photosensitive resin composition to reduce cost and to improve handleability (column 14, lines 55-67 & column 21, lines 33-46).

#### **(11) Related Proceeding(s) Appendix**


No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

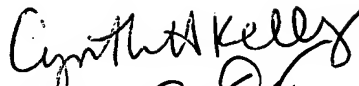
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Art Unit: 1795

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Respectfully submitted,

  
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